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October 26, 2015

Via ECF
Honorable Judge Ronald L. Ellis
United States Magistrate Judge
Daniel Patrick Moynihan U.S. Courthouse
500 Pearl Street
New York, New York 10007-1312

RE: Our File: FRANCO 6.0-003
Infinity Headwear & Apparel v. Jay Franco & Sons, et al.
Civil Action No.: 1:15-cv-01259-JPO-RLE

Dear Judge Ellis:

1) As Your Honor knows, Plaintiff and Defendants have filed with the Court all of their claim construction documents. Thus, the Franco Defendants are requesting that the Court schedule a claim construction hearing as soon as possible. Plaintiff's claims of patent infringement have damaged and are continuing to damage Defendants' sales and reputation in the marketplace. An expeditious ruling on claim construction will further a decision on the infringement issue in this case and provide Defendants' with certainty regarding their position in the marketplace.

The following documents have been filed with the Court regarding claim construction:

a) "Local Patent Rule 11 Joint Disputed Claim Terms Chart" (Dkt. 94) filed on **August 31, 2015**.

b) Plaintiff's "Opening Claim Construction Brief and Memorandum in Support" (Dkt. 96) with attached Exhibits 1 through 9, filed on **September 8, 2015**.

c) "Defendants' Responsive Claim Construction Brief" (Dkt. 99) filed on **October 8, 2015**, and the following supporting documents:

(i) "Declaration of Ezra Sutton" (Dkt. 100) authenticating attached Exhibits A through W; and
(ii) "Declaration of Dr. David Brookstein" (Dkt. 101) with attached Exhibits 1 through 3.

d) Plaintiff's "Reply Memorandum of Law" regarding claim construction (Dkt. 109) filed on October 21, 2015.

2) Further, Plaintiff's counsel, Mr. Burton, has served a subpoena to take the deposition of Dr. Brookstein on December 1, 2015, which Defendants have opposed primarily based on this Court's express prior ruling on October 14, 2015 (Dkt. 108 at 2), and the express scheduling of expert discovery in the March 17, 2015 "Scheduling Order," *inter alia*. Attached as **Exhibit A** is a copy of the email letter that Defendants' counsel sent to Mr. Burton **objecting** to Plaintiff's subpoena to depose Dr. Brookstein regarding his expert declaration on claim construction as one of at least ordinary skill in the art.

3) In addition, Defendants' counsel wishes to advise the Court that Plaintiff's counsel, Mr. Burton, has copied Dr. Brookstein (Defendants' expert) on certain emails wherein Plaintiff's counsel has criticized the substance of Dr. Brookstein's said expert declaration (Dkt. 101) and threatened to hold Dr. Brookstein "in contempt and seek all available sanctions against him" if he is not present for Plaintiff's scheduled December 1, 2015 subpoenaed deposition. In response, Dr. Brookstein has expressed his outrage regarding the intimidating and threatening nature of Mr. Burton's emails to him. Attached as **Exhibit B** is a letter from Dr. Brookstein sent to the undersigned objecting to the threats and intimidations of Mr. Burton, along with the emails from Mr. Burton.

To this end, Defendants note that courts have taken measures against the improper contact of expert witnesses by opposing counsel and with perceived witness intimidation where enforcement actions were threatened by opposing counsel: *See Kelly v. Panama Canal Comm'n*, 26 F.3d 597 (5th Cir. 1994) (sanctions for threatening criminal prosecution; employee may have been merely fact witness); *Campbell Indus. v. MN Gemini*, 619 E2d 24, 27 (9th Cir. 1980) (holding that ex parte contact with an expert violated FED. R. Civ P. 26); *Sewell v. Md. Dep't of Transp.*, 206 F.R.D. 545, 547 (D. Md. 2002) ("[Federal] Rule 26(b)(4) sets out specific and exclusive procedures for obtaining the opinions (and bases therefor) of experts who may testify for the opposing party.").

In summary, Defendants are requesting the following relief from the Court:

1) Scheduling a claim construction hearing as soon as possible in order to further a decision on the infringement issue in this case and provide certainty regarding Defendants' position in the marketplace;

2) Ordering that Plaintiff's counsel's subpoena to take the deposition of Dr. Brookstein be denied; and

3) Ordering that Plaintiff's counsel, Mr. Burton, should be prohibited from directly contacting Defendants' expert, Dr. Brookstein, and from threatening or intimidating him in the future.

Respectfully submitted,

EZRA SUTTON, Esq.

ES/mdp
Enclosures

cc: James Burton, Esq. (via ECF)
Dr. David Brookstein (via email)

EXHIBIT A

Ezra Sutton

From: Ezra Sutton <esutton@ezrasutton.com>
Sent: Friday, October 23, 2015 12:05 PM
To: 'James Burton'
Cc: 'Joshua S. Rupp'; 'Heather Mills'; Dr, David Brookstein
Subject: RE: Dr. Brookstein Deposition
Attachments: Order.pdf

Mr. Burton:

This is in reply to your email regarding your request to depose our expert witness, Dr. Brookstein.

First, as you know, on Oct. 14, 2015 Judge Ellis issued a Court Order (copy attached) denying your request for permission to depose Dr. Brookstein:

"(2) Infinity's motion to extend the deadline for its reply based on the completion date of Dr. Brookstein's deposition is DENIED."

(Dkt. 108 at 2). Therefore, your request to depose Dr. Brookstein at this time is in violation of the Judge's Order. In addition, as we pointed out in our letter to Judge Ellis opposing your request to depose Dr. Brookstein, there are a number of other reasons for objecting to this request.

Second, when you prepared the Scheduling Order, you made no provision for deposing an expert witness prior to the close of fact discovery. Specifically, the March 17, 2015 "Scheduling Order" states in relevant sections as follows:

"6. Fact Discovery

a. All fact discovery shall begin on March 17, 2015 and shall be completed 60 days after issuance of the Court's claim construction order (Markman Order).

* * *

7. Expert Discovery:

a. All expert discovery, including expert depositions, shall be completed no later than twenty-eight (28) days after service of the rebuttal expert reports in paragraph 7(c) below.

b. All expert disclosures (including expert reports) of parties bearing the burden of proof as to any issue shall be made no later than twenty-eight (28) days after the close of fact discovery.

c. All rebuttal expert disclosures (including rebuttal expert reports) shall be made no later than twenty-eight (28) days after service of the expert reports in 7(b)."

(Dkt. 37 at 2). Thus, according to the Scheduling Order the period for deposing expert witnesses does not open until after the close of fact discovery.

Third, when you prepared the Scheduling Order, you made no provision for deposing an expert witness regarding claim construction after your reply claim construction brief is filed (¶8(f)) and before the claim construction hearing. Specifically, the March 17, 2015 "Scheduling Order" states in relevant sections as follows:

"8. Claim Construction Process

* * *

d. No later than thirty (30) days after the filing of the Joint Disputed Claim Terms Chart pursuant to Local Patent Rule 11, the party asserting infringement must serve and file an opening claim construction brief and all supporting evidence and testimony.

e. No later than thirty (30) days after service of the opening claim construction brief, the opposing party must serve and file a response to the opening claim construction brief and all supporting evidence and testimony.

f. No later than seven (7) days after service of the response, the opening party may serve and file a reply solely rebutting the opposing party's response.

g. No later than seven (7) days prior to the claim construction hearing, the parties shall exchange their respective exhibits to be used at the hearing."

Thus, according to the Scheduling Order there is no provision for deposing expert witnesses regarding claim construction after the reply claim construction brief has been filed and before the hearing on claim construction.

Fourth, under Local Patent Rule 5:

"A party may object... to a discovery request as *conflicting with or premature* under these Local Patent Rules... if the... discovery request would require disclosure of information of the kind dealt with by Local Patent Rule... 12."

In addition, Local Patent Rule 12(c) regarding filing reply claim construction briefs does not permit depositions of experts regarding supporting declarations on claim construction *after* the "opening party serves and files a reply solely rebutting the opposing party's response."

Thus, Defendants object to Infinity's request to depose Dr. Brookstein regarding his claim construction declaration as there is no provision in the Local Patent Rules or Scheduling Order permitting the deposition of an expert regarding supporting a claim construction declaration after a reply brief has been filed or before the claim construction hearing.

Fifth, if Infinity wanted to dispute any of the statements made by Dr. Brookstein in his declaration, Infinity had more than enough time, including extended time, to file its own reply declaration of an expert witness, or other witnesses. However, it chose not to do so.

In view of the foregoing, your request is without a proper legal basis and is objected to. Since you have no legal basis for deposing Dr. Brookstein at this time, Plaintiff must properly file a motion with the Court requesting a modification of the Scheduling Order, which it has failed to do. We will oppose any such motion.

EZRA SUTTON
900 Route 9 North, Suite 201
Woodbridge, New Jersey 07095

EXHIBIT B

Ezra Sutton

From: Dr, David Brookstein <yarnboy@aol.com>
Sent: Monday, October 26, 2015 3:27 PM
To: esutton@ezrasutton.com
Subject: E mail I received from Mr. Burton on Friday

Dear Mr. Sutton

As you are aware I was copied on several e-mails from opposing counsel, James Burton, that I perceive as highly inappropriate. While I am not an attorney, it is my understanding that opposing counsel should never communicate with witnesses on the opposing side except at depositions or at hearings or trials. **Further, and perhaps most importantly I feel that I have been harassed and threatened by Mr. Burton's e-mails**. I have included an excerpts from his e-mail below.

If Dr. Brookstein doesn't appear, we will ask that the Court hold him in contempt and seek all available sanctions against him. Hopefully he will not rely upon your misguided advice as to the scope of the Court's order on which you mistakenly rely. (Fri, Oct 23, 2015 5:24 pm)

This is an e-mail, addressed to me, where Mr. Burton indicates that if I don't appear he will "*ask that the Court hold him in contempt and seek all available sanctions against him*" is threatening and harassing. Further, Mr. Burton impugns you to me as providing "*your misguided advice as to the scope of the Court's order on which you mistakenly rely*".

In closing, I have served as an expert witness for over 20 years and for more than 40 cases. I have never had opposing counsel communicate with me directly (other than in a deposition, hearing or trial). Further, and perhaps most importantly I have never been harassed or threatened by opposing counsel as I have been in the e-mail that I received from Mr. Burton on Friday October 23..

I trust that you will share my strong concerns with the Court. Further, I believe that Mr. Burton has explicitly demonstrated to me his **prejudice** to me and as such has made me intimidated to be deposed my him or anyone else in his firm that is representing the plaintiff for this case. Even if Mr. Burton decides to apologize for his inappropriate behavior, please keep in mind that he cannot "un ring the bell".

David Brookstein

Dr. David Brookstein
Fellow of the American Society of Mechanical Engineers
Engineering and Litigation Consultant

267-251-5090

Ezra Sutton

From: James Burton <jburton@kmclaw.com>
Sent: Friday, October 23, 2015 5:25 PM
To: esutton@ezrasutton.com
Cc: Joshua S. Rupp; Heather Mills; 'Dr, David Brookstein'
Subject: RE: Dr. Brookstein Deposition
Attachments: Brookstein Subpoena.pdf

Ezra:

Dr. Brookstein is not a trial expert; he is a claim construction expert. The rule you cite does not apply here as it is limited solely to trial preparation. Claim construction is not "trial preparation" under Rule 26 as claim construction will not be an issue at trial.

Moreover, we are not required to ask the Court's permission to take Dr. Brookstein's deposition nor do we intend to. It is your obligation to file a motion to quash or for a protective order. If Dr. Brookstein doesn't appear, we will ask that the Court hold him in contempt and seek all available sanctions against him. Hopefully he will not rely upon your misguided advice as to the scope of the Court's order on which you mistakenly rely.

Given his unavailability on November 20, we have reset the deposition for December 1, 2015, as reflected in the attached.

Best regards,

James Burton

Ezra Sutton

From: James Burton <jburton@kmclaw.com>
Sent: Friday, October 23, 2015 1:34 PM
To: esutton@ezrasutton.com
Cc: Joshua S. Rupp; Heather Mills; Dr, David Brookstein
Subject: RE: Dr. Brookstein Deposition
Attachments: Subpoena to Testify at a Deposition to David Brookstein.pdf

Ezra:

Needless to say, your analysis below is flawed and inaccurate. Please see the attached subpoena for Dr. Brookstein's deposition which we intend to serve as permitted by the Protective Order.

We intend to use Dr. Brookstein's deposition for two purposes. First, we intend to use his deposition to adequately prepare for the upcoming claim construction hearing.

Second, Dr. Brookstein's expert report is fatally deficient in several respects, including in its conclusory methodology, failure to comply with the basic requirements of Rule 26, and otherwise. Moreover, Dr. Brookstein's affidavit makes repeated improper legal conclusions and opinions, including improperly (albeit inaccurately) addressing infringement and invalidity, and appears to be nothing more than a rubber stamp to the attorney arguments in Franco's claim construction brief. As such, we intend to use his deposition testimony to support our forthcoming motion to exclude/strike Dr. Brookstein, as foreshadowed in our reply brief.

Best regards,

James Burton

James T. Burton
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